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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,728	12/14/2001	Joshua S. Auerbach	GB920010099US1	5443
46320 7590 06/06/2007 CAREY, RODRIGUEZ, GREENBERG & PAUL, LLP STEVEN M. GREENBERG 950 PENINSULA CORPORATE CIRCLE SUITE 3020 BOCA RATON, FL 33487			EXAMINER BLAIR, DOUGLAS B	
			ART UNIT 2142	PAPER NUMBER
			MAIL DATE 06/06/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/017,728	<b>Applicant(s)</b> AUERBACH ET AL.	
	<b>Examiner</b> Douglas B. Blair	<b>Art Unit</b> 2142	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 January 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 8-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

***Response to Appeal Brief***

1. In view of the Appeal Brief filed on 1/24/2007, PROSECUTION IS HEREBY REOPENED. A new grounds of rejection and a revision to the previously presented grounds of rejection are set forth below.

To avoid abandonment of the application, applicant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then applicant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

***Response to Arguments***

2. Applicant's arguments filed 1/24/2007 have been fully considered but they are not entirely persuasive. The applicant's final argument with respect to claim 8 on page 10 of the Appeal Brief is persuasive, however the rejection based on Herz has been revised to correct this

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deficiency. Also, the rejection of claim 10 as being anticipated by Herz is withdrawn. All other argument are addressed in this office letter and the rejection based on Herz has been revised in the hopes of eliminating the confusion that the applicant seems to be having about the Examiner's interpretation of the claims.

3. A new rejection has also been added based on newly published U.S. Patent Number 7,216,181 to Jannu et al. Though the applicant's specification is unclear as to what is meant by the claimed "first" and "second" type, Jannu seems to disclose this concept as best understood by the Examiner from a careful examination of the applicant's specification. Though it is not customary to reject a claim with more than one prior art rejection, in the case it is warranted because (a) the propriety of both the Jannu and Herz rejections depend on distinct interpretations of the claims and (b) Jannu could possibly be antedated by a 37 CFR 1.131 affidavit or declaration (See MPEP section 706.02(I)).

4. Finally, before addressing the applicant's arguments directly, the Examiner implores the applicant to explain how the claim language is to be interpreted in light of the applicant's specification in response to this office action. Every limitation is explicitly mapped in the following rejections so merely arguing that the limitations are not taught by the references without elaborating on how the limitations should be interpreted differently does nothing to further prosecution.

5. The arguments from the appeal brief are addressed as follows:

With respect to the cited portion of the Herz references the Applicant alleges that:

This passage cited by the Examiner does not teach anything with regard to receiving a subscription request of a first type, as recited in claim 8. Instead, the passage cited by the Examiner is just a collection of terms that the Herz has deemed to define.

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However, the previous office action clearly points out how the term subscription request is being interpreted. Specifically, in col. 4, line 49-col. 5, line 7 of Herz, the search profile or query contains keywords and target objects to request publications of interest and is thus considered a "subscription request".

The applicant further argues that:

Regarding the Examiner's specific assertion that "the search profile or query contains keywords and target objects to request publications of interest," although in definition (f), Herz teaches "a profile consisting of a collection of attributes, such that a user likes target objects whose profiles are similar to this collection, of attributes, is termed a 'search profile' or in some contexts a 'query' or 'query profile,'" Herz fails to teach that keywords and target objects are found in a subscription request, as recited in claim 8. Thus, there is no apparent teaching within this passage that a subscription request includes a first expression having at least one attribute, as recited in claim 8.

However, claim 8 does not even recite keywords and target objects so the applicant's statement that claim 8 does recite such features is fallacious. Even if, for argument's sake, claim 8 did recite such limitations Herz teaches these features as shown in col. 56, lines 21-25. The mentioned attributes can be keywords and target objects. The keywords and target objects are considered the filter expressions.

Next the applicant argues that:

Moreover, Applicants are unable to determine where, within this passage, Herz teaches the claimed receiving a subscription request of a first type. This passage within Herz is silent as to a subscription request, and thus, is also silent as to a "first type" of a subscription request. Therefore, the Examiner has failed to establish that Herz identically discloses the above-reproduced claimed invention within the meaning of 35 U.S.C. § 102.

However, this argument completely ignores the description (or lack there of) of a "first type" given by the applicant's specification. The only description the applicant's specification gives for types is that a subscription request is of type "A" and a publication is of type "B" (See

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page 18 of applicant's specification). There is no limiting definition of what a "type" comprises. Therefore the Examiner's interpretation that the "search profile" is of a "first type" and the "target profile" is of a "second type" is consistent with the applicant's broad disclosure.

The applicant goes on to allege that the Examiner must be relying on inherency. The Examiner, however, had made it clear how Herz reads on all of the applicant's claimed elements in the last office action and thus explicitly teaches the claimed invention. The applicant alleges that "a subscriber in Herz could submit a subscription request that is completely separate from the search parameters that are used." In response to this statement, the Examiner points out that the applicant provides no example from Herz that supports this conclusion and that the applicant's claims have nothing to do with a user anyway.

The applicant next argues that the cited passage of Herz does not show "mapping at least part of the at least one attribute to a generic format" and that:

Upon reviewing this passage, Applicants are unclear as to where, within this passage, Herz teaches mapping at least part of the at least one attribute to a generic format. Specifically, Applicants are unable to determine what feature within Herz identically discloses the claimed (i) generic format; (ii) the at least one attribute; and (iii) the mapping.

In response the Examiner points out that the applicant does not describe the claimed (i) generic format; (ii) that at least one attribute; and (iii) the mapping (See page 18 of the applicant's specification). Given that the applicant's specification provides no limiting definition for these terms, the reasoning previously supplied in the Final Rejection is all that can be expected of the Examiner. Specifically the Final Rejection stated that in Herz col. 57, lines 39-

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51, the search profiles are mapped to generic cluster profiles. As previously discussed the search profiles contain keywords and target objects, considered attributes.

The applicant then goes on to argue that:

As yet another example, independent claim 8, as originally presented, recites "receiving a publication message of a second type," and in the statement of the rejection regarding this limitation, the Examiner again cited column 4, line 49 through column 5, line 7 of Herz and asserted "the target profile." Upon reviewing this cited passage, which has already been reproduced above, Applicants are unclear as to how the teaching of "the target profile" identically discloses the claimed "receiving a publication message of a second type." Definition (b) of Herz states that "a digitally represented profile indicating that target object's attributes is termed a 'target profile'," which is silent as to both a "second type" and "receiving a publication message."

In response the Examiner points out that the "article" is considered the "publication message". The claims do not stipulate where it is received but only that it is received. In col. 57, line 6-col. 58, line 54, the Articles have clearly been received by the system of Herz at some point. As discussed previously, the applicant does not even describe a "second type" so the claim can only be interpreted broadly.

The applicant then argues that:

Independent claim 8, as amended, further recites "comparing the publication message received to the subscription request to determine whether the publication message is appropriate for forwarding onto the subscriber originating the request," and in the statement of the rejection regarding this limitation, the Examiner cited column 57, lines 8-36 and asserted "the search profile is compared with the target profile." In this regard, Applicants incorporate herein the arguments previously presented in the Pre-Appeal Brief Request for Review dated November 23, 2005. Specifically, reference is made to arguments entitled, "Examiner confusing 'specifying search parameters' with 'subscription request'"

In Herz, col. 57, lines 39-51 describe comparing the articles, considered publication messages, with the cluster of search profiles, considered subscription requests. This is done so that articles of interest can be forwarded to the subscribers who submit the search profiles. The

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Examiner is not confusing "specifying search parameters" with a "subscription request" as alleged by the applicant. Instead, the Examiner is equating "specifying search parameters" with a "subscription request". Given that the applicant's specification does not provide a limiting definition for a "subscription request", this is a reasonable interpretation.

The applicant finally argues that with respect to claim 8:

Independent claim 8, as originally presented, also recites "identifying a generic format filter attribute," and in the statement of the rejection regarding this limitation, the Examiner cited columns 57 and 58 and asserted "the target profile." Applicants note, however, that the Examiner also asserted that the claimed "receiving a publication message of a second type" is also disclosed by "the target profile." In this regard, Applicants are unclear as to how the Examiner can assert that the same taught feature (i.e., the target profile) can teach both "identifying a generic format filter attribute" and "receiving a publication message of a second type," as recited in claim 8.

This point is addressed in the rejection above. The search profile cluster is interpreted as the "generic filter attribute" and not the target profile. As pointed out above the "search profile cluster" is compared to the target profile that is of a "second type". As stated previously, the applicant's specification provides no details on how these limitations should be interpreted alternatively.

With respect to the dependent claims, the applicant alleges that the claim limitations are generally not taught without an elaboration. The explicit mapping of provided in the rejections of these claims shows how the claims are being interpreted. The rejection would not have been set forth if it was not believed that Herz taught the claim limitations.

*Specification*



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6. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the applicant's specification does not describe how a message can be "substantially empty" as claimed in claim 10. The term "substantially empty" appears to be a contradiction. The applicant's specification does not describe "temporary storage" as claimed in claim 14.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 8, 10, 11 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claim 8 recites the limitation "the step of comparing". The claims do not previously define the limitations as serious of steps. There is insufficient antecedent basis for this limitation in the claim.

10. Claim 10 recites the limitation "the step of preparing". The claims do not previously define the limitations as serious of steps. There is insufficient antecedent basis for this limitation in the claim.

11. Claims 11 and 13 recite the limitation "the step of mapping". The claims do not previously define the limitations as serious of steps. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 8-9 and 11-14 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Number 6,460,036 to Herz.

14. As to claim 8, Herz teaches a method for receiving publications and forwarding said publications on to parties who have subscribed to receive such publications, said method comprising:

receiving a subscription request of a first type, said request including a filter expression having at least one attribute (**col. 4, line 49-col. 5, line 7, the search profile or query contains keywords and target objects to request publications of interest, col. 56, lines 21-25 show search profiles containing keywords and attributes that are filter expressions**);

mapping at least a part of the at least one attribute to a generic format (**col. 57, lines 39-51, the search profiles are mapped to generic cluster profiles**);

receiving a publication message of a second type (**col. 4, lines 49-col. 5, line 22, the article which is used to create a target profile, col. 57, lines 20-29, the news articles, having target profiles, are clearly not the same "type" as the search profiles**);

comparing a publication message received the subscription request to determine whether the publication message is appropriate for forwarding onto a subscriber originating the request (**col. 57, lines 8-36, the search profile is compared with the target profile**), the step of comparing comprising:

identifying a generic format filter attribute (**cols. 57, lines 39-51, the cluster profile is a generic filter contains generic filter attributes**);  
mapping the generic format filter attribute to a format corresponding to the second message type (**col. 57, line 39-51, the clustered search profiles are mapped to the target objects**), the method further comprising:

transmitting said publication message to the originating subscriber (**col. 58, lines 28-31, the list of articles is presented to the user.**).

15. As to claim 9, Herz teaches the communications manager of claim 8, further comprising preparing the publication message for transmission to said originating subscriber (**col. 58, lines 25-54, the list of articles are prepared for the user.**).

16. As to claim 11, Herz teaches the communications manager of claim 8, 9, or 10, wherein said mapping at least part of an attribute to a generic format comprises: invoking a first component capable of understanding messages of said first type (**col. 57, lines 8-51, the search profiles are analyzed as described above**).

17. As to claim 12, Herz teaches the communications manager claims 8, 9, or 10 comprising: storing said generic format filter attribute (**col. 56, line 49-col. 57, line 5**).

18. As to claim 13, Herz teaches the communications manager of any preceding claim, wherein said mapping a generic format filter attribute to a format corresponding to the second

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message type comprises: invoking a second component capable understanding messages of said second type **(the target profiles are analyzed as described above)**.

19. As to claim 14, Herz teaches the communications manager of any preceding claim, wherein said format corresponding to the second message type is held in temporary storage until said comparison is complete **(col. 56, line 49-col. 57, line 5)**.

20. Claims 8-14 rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Number 7,216,181 to Jannu et al.

21. As to claim 8, Jannu teaches a method for receiving publications and forwarding said publication on to parties who have subscribed to receive such publications, said method comprising: receiving a subscription request **(col. 6, lines 9-11)** of a first type **(col. 6, lines 6-9, the "first" type could be a mainframe, CORBA, or JMS message)**, said request including a filter expression having at least one attribute **(col. 6, lines 16-22, the information which registers the interest is considered the filter expression with an attribute)**; receiving a publication message **(col. 6, line 18)** of a second type **(col. 6, lines 6-9, the "second" type could be a mainframe, CORBA, or JMS message)**; comparing the publication message received to the subscription request to determine whether the publication message is appropriate for forwarding onto a subscriber originating the request **(col. 6, lines 16-22)**, the step of comparing comprising: identifying a generic format filter attribute **(col. 6, lines 58-64, the structured event format)**; and mapping the generic format filter attribute to a format corresponding to the second message type **(col. 6, lines 58-64)**, the method further comprising: transmitting said publication message to the originating subscriber **(col. 6, lines 21-22)**.

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22. As to claim 9, Jannu teaches the method of claim 8, further comprising: preparing the publication message for transmission to said originating subscriber (**col. 6, lines 32-46**).

23. As to claim 10, Jannu teaches the method of claim 9, wherein the step of preparing the publication message for transmission to said originating subscriber comprises: creating a substantially empty message of said first type (**col. 6, lines 35-46**); extracting information from the publication message of said second type (**col. 6, lines 16-22**); and inputting said information into said substantially empty message (**col. 6, lines 16-22**).

24. As to claim 11, Jannu teaches the method of claim 10, wherein mapping at least part of an attribute to a generic format comprises: invoking a first component capable of understanding message of said first type (**The adapters shown in Figure 3**).

25. As to claim 12, Jannu teaches the method of claim 10, comprising: storing said generic format filter attribute (**col. 6, lines 58-64**).

26. As to claim 13, Jannu teaches the method of claim 10, wherein mapping a generic format filter attribute to a format corresponding to the second message type comprises: invoking a second component capable of understanding messages of said second type (**The adapters shown in Figure 3**).

27. As to claim 14, Jannu teaches the method of claim 10, wherein said format corresponding to the second message type is held in temporary storage until said comparing is complete (**col. 6, lines 58-64, the brokering server has RAM and is able to locate the adapters of the “second type”**).

### *Conclusion*

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28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas B. Blair whose telephone number is (571) 272-3893.

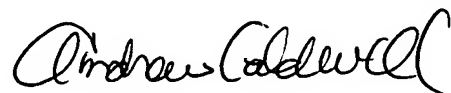
The examiner can normally be reached on 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Douglas Blair

DBB



ANDREW CALDWELL  
SUPERVISORY PATENT EXAMINER